



UNITED STATES
PATENT AND
TRADEMARK OFFICE

AUG 29 2002

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of :
Hubert Köster et al :
Serial No.: 09/171,625 : PETITION DECISION
Filed: July 2, 1999 :
Attorney Docket No.: 24743-2302 :

This is in response to the petition under 37 CFR 1.181, filed July 10, 2002, requesting withdrawal of the Finality of the last Office action.

A review of the file history shows that this application was filed under 35 U.S.C. 371 as the National Phase of PCT/US97/06509 which claims priority to Provisional application 60/015,699, filed April 17, 1996. The application, as filed, contains claims 1-36. In a first Office action mailed September 5, 2000, the examiner set forth a restriction/lack of unity requirement.

Applicants replied by electing Group I and traversing the Lack of Unity requirement by arguing that the requirement for election of species in a National Phase application is improper in view of the PCT Rules.

The examiner in the next Office action, mailed February 26, 2001, maintained the restriction requirement and made the requirement Final. The examiner acted on claims 1, 3-4 and 11-16 rejecting them under 35 U.S.C. 112, first and second paragraphs and under 35 U.S.C. 102(b) as anticipated by Montal et al, Saul et al and Stengele et al. Applicants then filed a petition with respect to the restriction requirement which was decided on September 6, 2001, and in which Groups I and IV were indicated as not subject to restriction under prosecution rules associated with applications filed under 35 U.S.C. 371. The examiner mailed a new Office action to applicants on December 4, 2001, setting forth a "new" restriction requirement but which was essentially identical to the first restriction requirement as to Groups I and IV (now Groups I and II) which were indicated as non-restrictable in the petition decision. Applicants elected to prosecute Group I and canceled the claims of Group IV. The examiner then mailed a new Office action to applicants on May 14, 2002, setting forth new rejections under 35 U.S.C. 112, first paragraph, for lack of description and lack of enablement and made the Office action Final. Applicants replied with this petition asking that the finality be withdrawn.

DISCUSSION

A review of the penultimate Office action on the merits, mailed February 26, 2001, shows that claims 1, 3-4 and 11-16 were elected and prosecuted, all other claims being withdrawn from prosecution. The examiner rejected claims 1, 3-4 and 11-16 under 35 U.S.C. 101 for lack of a specific or well-established utility and under 35 U.S.C. 112, first paragraph, for the same reasons. Additional rejections were made under 35 U.S.C. 112, first paragraph, for lack of description of the claimed invention in the specification, and for lack of enablement, and under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the invention. The claims were also rejected under 35 U.S.C. 102(b) as anticipated by Montal et al, Saul et al or Stengele et al. In reply, applicants amended claims 4, 11-16 and 26-28 while canceling claims 1-3, 5-10 and 17-25 and presented arguments with regard to each rejection. Following the petition decision the examiner mailed an Office action setting forth only a restriction requirement and not addressing applicants' arguments. Applicants replied with a proper election. The examiner mailed the next Office action to applicants on May 14, 2002, setting forth rejections under 35 U.S.C. 112, first paragraph, for lack of description and lack of enablement, but for different reasons than previously set forth. The examiner made the Office action Final including a statement that applicants' amendments necessitated the new grounds of rejection.

Applicants note that no amendments were made in response to the last Office action (the restriction requirement), but only in response to the Office action that preceded it. Applicants point out in their petition that claim 4, the main independent claim, is a combination of original claims 1, 3 and 4 and does not contain any new limitations. Claim 15, as amended, merely changes verb tense and is thus little different from original claim 15. The other claims remain essentially identical to the original claims except for dependency. Thus the claims could have been rejected for the reasons set forth in the last Office action in an earlier Office action, but were not. Further, the examiner's presentation of a restriction requirement on third action with no reference to applicants' amendments or arguments would lead applicants to presume that the arguments overcame the rejections of record. To then present new reasons for rejection which could have been previously presented proscribes applicant from having a proper opportunity to respond thereto.

DECISION

Applicants' petition is **GRANTED**. The finality of the Office action mailed May 14, 2002, is **withdrawn**.

Applicants remain under obligation to respond properly to the Office action mailed May 14, 2002, within the time period set therein, or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..



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